



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,934	08/07/2002	Axel Muntermann	(H)02MUN0018USP	9216

7590 10/25/2004

M Robert Kestenbaum
11011 Bermuda Dunes NE
Albuquerque, NM 87111

EXAMINER

PEFFLEY, MICHAEL F

ART UNIT	PAPER NUMBER
----------	--------------

3739

DATE MAILED: 10/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/049,934

Applicant(s)

MUNTERMANN, AXEL

Examiner

Michael Peffley

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-25 is/are allowed.
- 6) ☐ Claim(s) 1-9, 26, 28 and 29 is/are rejected.
- 7) ☒ Claim(s) 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3739

Applicant's amendments and comments, received August 23, 2004 have been fully considered by the examiner. It is noted that applicant has clarified that both independent claim 1 and independent claim 29 are product-by-process claims, and that claim 29 is not intended to include the specific method steps of claim 10. It is noted that the process is not given patentable weight in product-by-process claims (see MPEP 2113). Also, it is noted that applicant has amended independent method claim 10 to recite method steps, which amendment has obviated the 35 USC 112 rejections. Similarly, the amendments to claims 26-28 have obviated 35 USC 101 and 35 USC 112 rejections. The following is a complete response to the August 23, 2004 communication.

Claim Objections

Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Independent claim 1 has been amended to recite the subject matter found in dependent claim 3 making claim 3 redundant.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3739

Claims 1-9 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Cunningham et al ('671).

Cunningham et al discloses an electrode with a rounded tip. As asserted previously, it is impossible to determine what constitutes a "reduced number of electrical interference centers". The Cunningham et al electrode will inherently have a "reduced" number of such centers compared to at least other electrode known in the art. It is noted that the wherein clause added by amendment to claim 1 is directed to a product by process, and weight is not given to the process of making the product (see MPEP 2113). Further, the Cunningham et al electrode is subjected to various electrolytes (e.g. saline and blood) and is made from platinum.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham et al ('671) in view of the teaching of Eggers et al ('700).

Cunningham et al provide an electrode which presents a "reduced number of electrical interference centers" as set forth in claim 1. Further, Cunningham et al teach of providing the electrode in an electrolyte solution such as blood and/or saline fluid. However, Cunningham et al fail to specifically disclose a second electrode (e.g. return electrode) which is in contact with the solution.

Eggers et al disclose an analogous catheter device, and specifically teach that it is generally well-known in the art to provide such an electrosurgical ablation catheter with a return electrode on the catheter in proximity to the treatment electrode and in contact with a solution containing ions (i.e. saline or blood). An electric voltage is applied to the electrodes.

While it is noted that applicant's intent is to claim a much different device/process than is taught by the prior art, the claims, as presently written, are sufficiently broad so as to be anticipated and obviated by the prior art as applied.

To have provided the Cunningham et al catheter as a bipolar catheter system having both active and return electrodes on the catheter body for the treatment of tissue would have been an obvious modification for one of ordinary skill in the art in view of the teaching of Eggers et al.

Terminal Disclaimer

The terminal disclaimer filed on August 23, 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Application Serial No. 10/049,932 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Allowable Subject Matter

Claims 10-25 are allowed.

Claim 27 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to the pending claims have been fully considered and are not deemed persuasive.

The applicant contends that the Cunningham et al reference fails to discuss the microscopic surface quality of the electrode. In particular, applicant points out that Cunningham et al does not disclose any electrode with a treated surface to reduce the number of electrical interference centers. First, the examiner posits that there is nothing in the claims specifically addressing the microscopic surface quality of an electrode. Rather, the claim merely recites a reduced number of electrical interferences. It is the examiner's position that this very broad recitation only imparts to the claim that the electrode must have been treated in some way to reduce electrical interference. The Cunningham et al electrode is specifically designed with rounded edges to reduce electrical interference and is therefore deemed to read on the broad recitation of having "a reduced number of electrical interference centers". Second, the "wherein" clause added to claim 1 merely recites the process by which the product (i.e. electrode) was made. As per MPEP 2113, no patentable weight is given to the process steps in a product-by-process claim. The examiner only needs show that the product (i.e. electrode) is the same. Again, the examiner maintains that the Cunningham et al electrode has a reduced number of electrical interference centers and meets the structural limitations of claims 1 and 29.

With regard to independent claim 26, the examiner maintains that the combination of the Cunningham et al reference with the Eggers et al teaching is tenable

Art Unit: 3739

and obviates the claim language. Cunningham et al provide a catheter having an electrode, the catheter and electrode being inserted into a blood vessel which contains an electrolytic solution (i.e. blood). A voltage generating current is connected to the electrode. Cunningham et al simply do not teach an additional electrode on the catheter as it is operated in a monopolar mode. Eggers et al teach that it is generally known to provide ablation catheters with a proximally located return electrode for bipolar operation, in which case both electrodes (i.e. active and return) are located in the blood vessel and in the blood (i.e. electrolytic solution). The examiner maintains that it would have been obvious to have provided the Cunningham et al catheter with a return electrode to allow for the ablation of tissue in a bipolar mode in view of the teaching of Eggers et al. It is noted that applicant's invention is intended to be directed to a much different system from the cited prior art. However, the examiner maintains that the current claim language remains sufficiently broad that the rejections as cited remain tenable.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

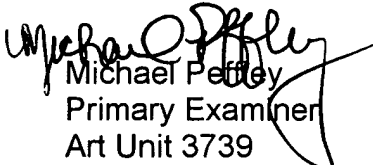
Art Unit: 3739

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (703) 308-4305. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Michael Peffley
Primary Examiner
Art Unit 3739

mp
October 21, 2004